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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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GATEWAY, INC. ATTN: Patent Attorney 610 GATEWAY DRIVE MAIL DROP Y-04 N. SIOUX CITY, SD 57049			EXAMINER MURDOUGH, JOSHUA A	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 03/17/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/625,151

Applicant(s)

ANDERSON ET AL.

Examiner

JOSHUA MURDOUGH

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 23 and 34-45 is/are pending in the application.
- 4a) Of the above claim(s) 43 and 45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 23, 34-42 and 44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. This action is responsive to Applicants' amendment received 15 December 2008.
2. This amendment cancelled claims 7-22 and 24-33.
3. New claims 34-45 have been added.
4. Claims 1-6, 23, and 34-45 are pending.
5. Claims 43 and 45 are withdrawn from consideration herein.
6. Claims 1-6, 23, 34-42, and 44 have been examined on the merits.
7. This action has been assigned paper number 20090309 for reference purposes only.

Election/Restrictions

8. The Examiner previously issued a restriction requirement with the following groups:
 - I. Claims 1-6 and 23, drawn to software enablement, classified in class 705, subclass 59.
 - II. Claims 7-12 and 19-22, drawn to initializing software on a device, classified in class 705, subclass 73.
 - III. Claims 13-18, drawn to a point of sale system, classified in class 705, subclass 64.
 - IV. Claims 24-33, drawn to copy authentication with a program ID, classified in class 705, subclass 58.
9. Applicants elected Group I without traverse on 9 July 2008.
10. Claims to the non-elected groups (7-22 and 24-33) have been canceled. Therefore, claims to Groups II-IV are no longer pending. However, the Examiner has included these groups

for completeness, and not as an active part of the current restriction. Also, the numbering has been maintained for clarity.

11. Applicants' latest amendment, received 15 December 2008, contains claims directed toward inventions other than the one previously elected.

12. Restriction to one of the following inventions is required under 35 U.S.C. §121:

- I. Claims 1-6, 23, 34-42, and 44; drawn to software enablement, classified in class 705, subclass 59.
- V. Claims 43 and 45, drawn to configuration of an electronic device, classified in class 705, subclass 56.

The inventions are distinct, each from the other because of the following reasons:

13. Inventions I and V are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not need to find the product code as the product was not previously purchased, but is instead being installed on the device prior to being sent to the customer. The subcombination has separate utility such as in software licensing.

14. The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 C.F.R.

§1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

15. Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. §101 and/or 35 U.S.C. §112, first paragraph.

16. Applicants have already elected Invention I. Therefore, no election response is needed. As such, no call was made to solicit such a response.

17. Newly submitted claims 43 and 45 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: they represent a

combination whereas the previously elected claims represent a subcombination as demonstrated above.

18. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 43 and 45 are withdrawn from consideration as being directed to a non-elected invention. See 37 C.F.R. § 1.142(b) and MPEP § 821.03.

Drawings

19. The Examiner previously objected to Figure 1 for not showing the "software" as described in the specification. Upon further review, the Examiner interprets the "controller" **157** as being software as described on page 6, lines 1-5 of the specification. If this interpretation is not what was intended by Applicants, they should indicate the proper interpretation and show support for it in their next response.

Specification

20. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. § 1.75(d)(1), MPEP § 2181 and its discussion of C.F.R. § 1.75(d)(1), and MPEP § 608.01(o). Correction of the following is required:

- a. The "means for receiving," in at least claim 23;
- b. The "means for finding," in at least claim 23; and
- c. The "means for sending," in at least claim 23.

Claim Objections

21. Claims 1 and 23 are objected to because of the following informalities: Triple brackets have been used to indicate the removal of words from these claims. This is not the proper way to amend a claim. "The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters" (MPEP § 714 (c) (2)). If this is not followed in the future, the amendment will be held non-compliant. In order to further the prosecution, the Examiner has treated these amendments as though they were proper as Applicants intent is clear.

Claim Rejections - 35 USC § 112

22. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

23. Claim 23 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

24. Claim 23 contains means-plus-function limitations ("means for receiving," "means for finding," and "means for sending"). For each of these limitations, Applicants have argued that, as set out by the specification, the means is the controller 171. As described in the specification, the controller "includes instructions capable of executing on a processor" or it "may be implemented in hardware" (Page 8, Lines 14-17). One of ordinary skill in the art would recognize that there are a vast number of possible hardware implementations including: logic gates, processors, programmable devices, and combinations thereof. As Applicants have failed

to clearly link and associate the specific hardware to the function being performed, one of ordinary skill in the art would not understand the metes and bounds of the system. The Examiner has interpreted the instructions executing on a processor as the structure for all of the means-plus-function limitations. If the "may be implemented in hardware" interpretation is removed, this rejection would be withdrawn.

25. Claim 23, as a result of the above interpretation, is also indefinite because the notice function of the claim is not fulfilled. One of ordinary skill in the art would not recognize whether one processor or three processors are needed in order to infringe on this claim, if it were allowed in its present form. As each means-plus-function limitation is interpreted as instructions executing on a processor, it is not clear if there are three processors, one associated with each function, or just one that executes all three sets of instructions. While the Examiner recognizes that a system configured in either manner would be able to perform the recited functions, one of ordinary skill would not be able to determine if they infringe if they only have one processor.

Claim Rejections - 35 USC § 103

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. Claims 1-3, 5, 6, 23, 35, 36, 38-42, and 44, as understood by the Examiner, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hillegass (US 2002/0007351).

28. As to claim 1, Hillegass shows in their invention:
- d. A method comprising:
 - e. receiving a request **600** from an electronic device **501** for a product code (“LicenseID,” Figure 4) for a previously purchased product (“DatePurchased,” Figure 3), the request including an identification from the electronic device (“UserID,” Figure 1);
 - f. finding a product code associated with the identification [0009]; and
 - g. sending the product code to the electronic device **725**;
 - h. wherein the product code enables use of the product on the electronic device **26**,
29. Hillegass does not expressly show the following as part of their invention:
- i. said product not being usable on the electronic device until being enabled with the product code.
30. However, Hillegass does show that is was known at the time of the invention to prevent access to unlicensed content [0007]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Hillegass to include the prevention of access to the product when a license is not present. This would allow “authors and producers of copyrightable materials seek secure ways of distributing copyrightable materials in electronic form to purchasers of the materials, and allowing these bona fide purchasers convenient access to the purchased materials, while at the same time preventing subsequent unauthorized copying” (Id.).
31. As to claim 2, Hillegrass further shows:

- j. copying the product code (“LicenseID” as part of the token, Figure 4), to a database **510** when the product is purchased **620**,
 - k. the copying the product code to the database including associating the product code with the identification (“UserID” as part of the token, Figure 1) in the database (“Token” in “Database” **510**, Figure 1).
32. As to claim 3, Hillegass further shows:
- l. the finding the product code further comprises finding the product code in the database using the identification of the received request **820**.
33. As to claim 5, Hillegass further shows:
- m. the identification identifies the electronic device (the “UserID” is stored on the user device **501**, Figure 1).
34. As to claim 6, Hillegass further shows:
- n. the identification identifies a customer [0029].
35. As to claim 23, Hillegass as applied to claim 1 shows the claimed functionalities. As per the discussion above regarding the means-plus-function language, the corresponding structure has been interpreted as being software and a processor. Hillegass shows the functions are performed by software **515** executed on a computer [0028] which inherently includes a

processor.

36. As to claim 35, Hillegass further shows:

o. retrieving the product code from the server to enable use of the product on the electronic device when the product is reinstalled on the electronic device [0012].

37. As to claim 36, Hillegass further shows:

p. inserting the product code into an installation routine for reinstalling the previously purchased product to enable use of the product on the electronic device [0037].

38. As to claim 38, Hillegass further shows:

q. the request for the product code is sent by the electronic device during an attempt to install the product on the electronic device [0009].

39. As to claim 39, Hillegass further shows:

r. the request for the product code is sent by the electronic device as a part of an installation process to install the product on the electronic device [0009] (Figure 7).

40. As to claim 40, Hillegass further shows:

s. the request by the electronic device is transmitted over a network **30** [0045], and the product code is sent over the network to the electronic device [0045].

41. As to claim 41, Hillegass further shows:

t. the product was previously loaded on the electronic device making the request (Step 23, Figure 7), and the request for the product code is made as part of a reinstallation process for the product on the electronic device [0009].

42. As to claim 42, Hillegass further shows:

u. the sending of the product code (Step 24, Figure 7) does not include sending the product (Step 23, Figure 7) for which the product code enables use (Step 26, Figure 7).

43. As to claim 44, Hillegass as applied to claim 1 shows the claimed functionalities.

Hillegass further shows the functions are performed by software **515**, which is necessarily stored on a medium, executed on a computer [0028] which inherently includes a processor.

44. Claims 4, 34, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hillegass as applied to claim 1 above, and further in view of Roberts (US 7,363,025).

45. Hillegass shows as detailed above in regards to claim 1 and further shows:

v. sending the product code and the identification to a server **500** when the product is purchased ("Token Purchase," Figure 1); and

- w. copying the product code and the identification to a database **510** on the server **500** (Figure 1)
46. Hillegass, does not expressly show:
- x. copying the product code to a database when the product and the electronic device are purchased (Figure 4, Step 34 & Figure 7);
 - y. loading the product onto the electronic device by a manufacturer of the electronic device; and
 - z. loading the product code for the product onto the electronic device.
47. Roberts shows the registration of preloaded software by a “build-to-order configuration engine” at the manufacturer (Claim 17). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have further modified the teachings of Hillegass to include the registered, preloaded software as taught by Roberts because, “[m]anufacturers of various handheld devices sometimes place sample software modules on the Internet in order to encourage developers to build add-on utilities for their devices” (C 3, LL 27-30).

Response to Arguments

48. Applicant's arguments filed 15 December 2008 have been fully considered but they are not persuasive.
49. Applicants argue:
50. “[I]t is noted that the specification states at page 8, lines 14 through 17, that:

In an embodiment, the controller 171 includes instructions capable of executing on a processor (not shown) to perform functions, as further described below with respect to Fig. 3. In another embodiment the controller 171 may be implemented in hardware" (Remarks, Page 9, partial paragraph).

51. Examiner's response:

52. While the controller is said to perform functions, it is not clearly linked and associated with the means-plus-function limitations. If this is what was intended, the specification should be amended to show this. As always, amendments may not present new matter.

53. The specification makes reference to Figure 3 for the functions of the software. However, it is unclear which steps of Figure 3 correspond to the different means-plus-function limitations.

54. Moreover, the specification says the controller could be implemented in hardware. Hardware is not a specific structure. As noted above, one of ordinary skill in the art would be able to arrive at a large number of possible structures. However, they would not know if any of them are the particular structure intended by Applicants.

55. Applicants argue:

56. "These different ways of implementing the functions of the "means for" clauses is recognized in the specification, such as the portion of the specification set forth above, where it states that the controller "includes instructions capable of executing on a processor" and that the controller "may be implemented in hardware" (Remarks, Page 9, Paragraph 1).

57. Examiner's response:

58. What specifically are the ways?

59. Applicants argue:

60. "It is also submitted that applicant is not required to limit the controller only to hardware, software, or a combination of the two in order to avoid indefiniteness in the claim" (Remarks, Page 9, Paragraph 1).

61. Examiner's response:

62. The Examiner agrees. However Applicant is required to specify the corresponding structure that performs the claimed functions.

63. Applicants argue:

64. "As to paragraph 10, it is submitted that neither the claim language nor the specification need to specify that the functions of the means claims are performed by only one processor or different processors for each function" (Remarks, Page 9, Paragraph 2).

65. Examiner's response:

66. Again, the Examiner agrees. However Applicant is required to specify the corresponding structure that performs the claimed functions. While a processor or three processors are not required, Applicants are required to show the specific structure that corresponds to each of the means-plus-function limitations and clearly link and associate the structure to the function.

“[P]ursuant to [35 U.S.C. 112, sixth paragraph], structure disclosed in the specification is corresponding’ structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim. This duty to link or associate structure to function is the quid pro quo for the convenience of employing 112, paragraph 6” (MPEP § 2182). See also, MPEP § 2181.

67. Applicants argue:

68. “It is submitted that the invention is not limited to being performed on one processor, and that the claim does not have to be limited to one processor or multiple processors to avoid indefiniteness” (Remarks, Page 10, partial paragraph).

69. Examiner’s response:

70. The Examiner again agrees that the claim does not have to be limited to one processor or multiple processors to avoid indefiniteness. However, Applicant now appears to be arguing that the corresponding structure is instructions alone. If Applicants insist that this is the corresponding structure and do not add other structure to this claim, this claim will likely receive a rejection under 35 USC 101 for being directed toward software per se.

71. Because Applicant has not particularly pointed out and distinctly set forth the corresponding structure for the “means for” phrases, the rejections under 35 USC 112 2nd paragraph have been maintained. See *Aristocrat Technologies, Inc. v. International Game Technology*, 521 F.3d 1328, 86 USPQ2d 1235 (Fed. Cir. 2008).

72. Applicant's arguments with respect to the art rejections of claims 1-6, 23, 34-42, and 44 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

73. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

74. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

75. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

76. White ("How Computers Work"), shows the basic structures present in a computer.

77. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The Examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

78. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

79. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Joshua Murdough
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621